



UNITED STATES PATENT AND TRADEMARK OFFICE

200.1079US

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TECH CENTER 1600/2900

Re: Application of: BURCH et al.
Serial No.: 09/154,354
Group No.: 1627
Filed: September 17, 1998
For: SYNERGISTIC COMBINATION OF OPIOID ANALGESIC
AND CYCLOOXYGENASE-2 INHIBITOR

Information Disclosure Statement under 37 C.F.R. § 1.97(b)(4) or alternatively under 37
C.F.R. § 1.97(c)(1) with accompanying statement under 37 C.F.R. § 1.97(e)

Assistant Commissioner for Patents
Washington, D.C. 20231

September 26, 2001

Sir:

In accordance with Applicant's duty of disclosure under 37 C.F.R. § 1.56 and pursuant to 37 C.F.R. § 1.97(b)(4), Applicants hereby make of record the documents listed on the accompanying Form PTO-1449 for consideration by the Examiner in connection with the examination of the above-identified application. It is believed that this Information Disclosure Statement is submitted before a first Office Action after the filing of a request for continued examination, therefore no fee is due.

In the event an Office Action has been mailed, this Information Disclosure Statement is filed under 37 C.F.R. § 1.97(c)(1) with a statement under 37 C.F.R. § 1.97(e) declaring that each item of information contained in the Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.

I hereby certify that the documents referred to as attached therein and/or fee are being deposited with the United States Postal Service with sufficient postage as "first class mail" in an envelope addressed to "Assistant Commissioner for Patents, Washington, D.C. 20231" on September 26, 2001.

DAVIDSON, DAVIDSON & KAPPEL, LLC

BY: J. Daniel Fantarot

It is pointed out to the Examiner that all of the cited references (AE through AO) were cited in the European Search Report from the corresponding European application. A copy of the search report is enclosed.

It is respectfully requested that the references cited on the accompanying PTO Form-1449 be considered and made of record. If any of the publications listed thereon are missing, the Examiner is requested to contact the undersigned so that a copy can be promptly forwarded.

In the event that it is determined that any additional fee is due, the Examiner is authorized to charge said fee to DAVIDSON, DAVIDSON & KAPPEL, LLC, Deposit Account No. 50-0552. A duplicate copy of this sheet is enclosed.

It is respectfully submitted that the pending claims are patentable over all the references made of record at this time.

Respectfully submitted,

DAVIDSON, DAVIDSON & KAPPEL, LLC

By: 

Robert J. Paradiso
Reg. No. 41,240

Davidson, Davidson & Kappel, LLC
485 Seventh Avenue, 14th Floor
New York, New York 10018
(212) 736-1940

UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: K. McMILLAN

Art Unit: 1614

Re: Application of:

Ronald M. BURCH, et al.

Serial No.:

09/154,354

Filed:

September 17, 1998

For:

ANALGESIC COMBINATION OF
OXYCODONE AND ROFECOXIBRECEIVED
DEC 02 2002
TECH CENTER 1600/2900SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT
UNDER 37 C.F.R. §1.56Box: ISSUE FEE
Assistant Commissioner for Patents
Washington, D.C. 20231

September 13, 2002

Sir:

In accordance with the provisions of 37 C.F.R. §§ 1.56 and 1.97, Applicants hereby make of record the following: Statement Of Ground and Particulars in Support of Opposition attached as Appendix A (20 pages); Claims of Australian Patent Application No. 742097 (93984/98) attached as Appendix B (5 pages); and Form PTO-1449 (2 pages) with copies of cited references pursuant to 37 C.F.R. § 1.98(d).

Attached as Appendix A is a Statement of Grounds and Particulars in Support of Opposition dated June 14, 2002, brought by Pharmacia Corporation at the Australian Patent Office opposing Australian Patent Application No. 742097 (93984/98), the corresponding Australian application of the present U.S. application.

Attached as Appendix B is a copy of the current claims of Australian Patent Application No. 742097 (93984/98), which claims the same priority as the present application.

References D1 to D7 (pages 2 to 4 of the statement of Appendix A), D9 to D16 (pages 5 to 7 of the statement of Appendix A) and D21 to D37 (pages 8 to 11 of the statement of Appendix A), correspond to references AA through BM of attached Form PTO-1449.

References D8 (page 5 of the statement of Appendix A) and D17 to D20 (page 7 to page 8 of the statement of Appendix A) are not listed on the accompanying Form PTO-1449 as these references have already been made of record in the present application. Specifically, reference D8 was cited as reference AA (on Form PTO-1449 labeled 1 of 1) and references D17, D18, D19, and D20 were cited as references BB, BD, BF, and BH, respectively, (on Form PTO-1499 labeled 2 of 2), in the Information Disclosure Statement filed June 7, 1999.

This Information Disclosure Statement and accompanying Form PTO-1449 are being filed after a notice of allowance under §1.311 but before the payment of the issue fee in accordance with C.F.R. §§ 1.97(d) and 1.97(e).

In accordance with C.F.R. § 1.97(e)(2), it is stated that no item of information contained in the Information Disclosure Statement filed herewith was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 CFR 1.56(c) more than three (3) months prior to the filing of this Information Disclosure Statement.

A check in the amount of \$180.00 is enclosed to satisfy the fee requirement due under 1.17(p) for filing this Information Disclosure Statement.

It is respectfully requested that the references cited in the accompanying Form PTO-1449 be considered by the Examiner and made of record. If any of the listed references are missing, the Examiner is requested to contact the undersigned so that a copy may be promptly forwarded.

In the event any additional fee is due or overpayment made in connection with the filing of this Information Disclosure Statement, the Assistant Commissioner is hereby authorized to charge said deficiency or credit overpayment to our Deposit Account No. 50-0552.

Respectfully Submitted,

DAVIDSON, DAVIDSON & KAPPEL, LLC

By: 

Robert J. Paradiso
Reg. No. 41,240

Davidson, Davidson & Kappel, LLC
485 Seventh Avenue, 14th Floor
New York, New York 10018
(212) 736-1940